

Appl. No. 10/064,944
Amdt. Dated August 8, 2005
Reply to Office Action of June 10, 2005

REMARKS

A telephone conference was conducted by the undersigned attorney with Examiner Cindy Nguyen to discuss this matter on August 8, 2005. The parties were unsuccessful in reaching an agreement as to the appropriateness of the finality of the present Office Action. Accordingly, Applicant is filing this paper to formally request reconsideration.

In a first Office Action, dated December 14, 2004, Claims 1-9 and 11-13, were rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,704,729 to Klein et al. (hereinafter "Klein"). Claim 10, which depends from Claim 1, was rejected under 35 U.S.C. 103(a) as unpatentable over Klein in view of U.S. Patent No. 6,647,383 to August et al.

With respect to independent Claim 1, the Action held that Klein disclosed all the requirements of Claim 1 including the step of "associating said initial search term to *any* topical categories related to said initial topical category" [Emphasis added].

However, as was pointed out in the Amendment filed on April 7, 2005, the limitation of Claim 1 required the step of "associating said initial search term to *all* topical categories related to said initial topical category. . . ." [Emphasis added]. This was not a minor misunderstanding by the Examiner. Applicant argued that this limitation, *inter alia*, was not disclosed in Klein.

The Examiner agreed with this argument as evidenced by the subsequent Action. The second Office Action, dated June 10, 2005, rejected pending Claims 1 and 3-16 under 103(a), no longer under 102(e), as unpatentable over Klein in view of U.S. Patent No. 6,785,671 to Bailey et al. (hereinafter "Bailey"). This Action was made final, as the Examiner contends, because "Applicant's amendments necessitated the new ground(s) of rejection presented in this Office Action." However, the agreement by the Examiner to Applicant's argument is within the Action.

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which states that Klein now fails to disclose the step of "associating said initial search term to all topical categories related to said initial topical category. . . ." (See PTO Action, dated June 10, 2005, page 4).

If the Applicant had not amended the claims to add a further limitation, the Examiner would still have been required to alter her rejection of the pending claims. She has implicitly acknowledged misapplying Klein in the first Office Action.

Accordingly, the new ground of rejection was not necessitated by any amendment made by Applicant, but rather it was necessitated by the improper 102(e) rejection initially advanced in the Action of December 12, 2004. Further, the Bailey reference is newly cited by the Examiner and was not submitted in any Information Disclosure Statement filed by Applicant.

According to MPEP 706.07(a)

"second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. . . ." [Emphasis added].

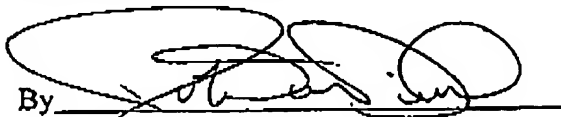
Examiner Nguyen argued in the telephone conference that the added limitation to Claim 1 by Applicant changed the scope of the claim and required a new search. While this may be true, the new search is irrelevant to the consideration of what constitutes a proper final rejection. Applicant's amendment was not the cause of the new ground of rejection. The Examiner certainly had to consider the added limitation as she prepared the second Office Action, but, as previously stated, even without the amendment, the Examiner would have needed to introduce a new ground of rejection because she misread an important claim limitation while rejecting the pending application the first time. To make the present Office Action final would be tantamount to punishing the applicant for a Patent Office mistake.

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MPEP 706.07(c) and (d) allow the Examiner to withdraw, as premature, the finality of a rejection after a timely filed request for reconsideration by Applicants. In the present instance, the finality of the June 10 Office Action is clearly premature. Applicant hereby requests withdrawal of the same and notice to that effect at the Examiner's earliest convenience.

A phone call to the undersigned attorney upon a decision on the merits of this request, given the timing of the deadline for Reply to the June 10 Action, is respectfully requested and would be greatly appreciated.

Respectfully submitted,

By 

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